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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/911,963	07/23/2001	James B. Terry	1391-10210	7967

23505 7590 12/04/2001
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EXAMINER

LEE, JONG SUK

ART UNIT	PAPER NUMBER
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3673

DATE MAILED: 12/04/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/911,963

Applicant(s)

TERRY ET AL.

Examiner

Jong-Suk (James) Lee

Art Unit

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-- **Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --**
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,7,10-13,15 and 17-63 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-3,7,10-13,15 and 17-63 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____

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DETAILED ACTION

1. The preliminary amendment filed July 23, 2001 has been entered.

Election/Restriction

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claims 1-3, 7, 10-13, 15, 17-25, 33-35 and 38-62, drawn to a drilling system for drilling a bore hole into a formation, classified in class 175, subclass 73.
 - II. Claims 26 and 27, drawn to a connector for connecting lengths of a composite pipe, classified in class 175, subclass 320.
 - III. Claim 28, drawn to a propulsion system, classified in class 175, subclass 99.
 - IV. Claims 29, 30 and 63, drawn to a steerable assembly, classified in class 175, subclass 73.
 - V. Claim 31 and 32, drawn to a bottom hole assembly, classified in class 175, subclass 50.
 - VI. Claim 36, drawn to an apparatus for cutting an aperture in an existing cased borehole, classified in class 166, subclass 55.
 - VII. Claim 37, drawn to an apparatus for installing a joint of casing on a casing string

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1 extending into a well, classified in class 166, subclass 77.4.

2

3 3. Inventions of Groups I-V, Group VI and Group VII are unrelated. Inventions are

4 unrelated if it can be shown that they are not disclosed as capable of use together and they have

5 different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP

6 § 808.01). In the instant case the different inventions of Group I-V, VI and VII respectively are

7 the system for drilling a borehole with a composite umbilical drill string into a formation; the

8 system for cutting an aperture on the borehole casing by utilizing a template reciprocally mounted

9 within a housing and a cutting member movably mounted within the housing; and the system for

10 installing and removing steel pipe.

11 4. Inventions of Group I and Group II are related as combination and subcombination.

12 Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed

13 does not require the particulars of the subcombination as claimed for patentability, and (2) that the

14 subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant

15 case, the combination as claimed does not require the particulars of the subcombination as

16 claimed because the subcombination requires, among other things, a connector. The

17 subcombination has separate utility such as it can be used in connecting the tubular member, i.e.,

18 steel pipes.

19 5. Inventions of Group I and Group III are related as combination and subcombination.

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1 Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed
2 does not require the particulars of the subcombination as claimed for patentability, and (2) that the
3 subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant
4 case, the combination as claimed does not require the particulars of the subcombination as
5 claimed because the subcombination requires, among other things, a propulsion system. The
6 subcombination has separate utility such as it can be used in pulling a sensor, i.e., video camera
7 into well casing.

8 6. Inventions of Group I and Group IV are related as combination and subcombination.

9 Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed
10 does not require the particulars of the subcombination as claimed for patentability, and (2) that the
11 subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant
12 case, the combination as claimed does not require the particulars of the subcombination as
13 claimed because the subcombination requires, among other things, a steerable assembly. The
14 subcombination has separate utility such as it can be used in pulling a repairing tool into well
15 casing.

16 7. Inventions of Group I and Group V are related as combination and subcombination.

17 Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed
18 does not require the particulars of the subcombination as claimed for patentability, and (2) that the
19 subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant

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1 case, the combination as claimed does not require the particulars of the subcombination as
2 claimed because the subcombination requires, among other things, a bottom hole assembly. The
3 subcombination has separate utility such as it can be used in retrieving sensors and repairing tools
4 from the well tubes.

5 8. Inventions of Groups II, III, IV, and V respectively each other are related as
6 subcombinations disclosed as usable together in a single combination. The subcombinations are
7 distinct from each other if they are shown to be separately usable. In the instant case, invention of
8 Group II, III, IV and V respectively has separate utility such as it can be used in a system or
9 apparatus without the composite umbilical drill string (tube). See MPEP § 806.05(d).

10
11 9. Examiner attempted to make a telephone call to applicant's attorney, Mr. David A. Rose
12 (Reg. No. 26,223) on November 30, 2001 to request an oral election to the above restriction
13 requirement, but failed to contact the applicant's attorney.

14 Applicant is advised that the reply to this requirement to be complete must include an
15 election of the invention to be examined even though the requirement be traversed (37
16 CFR 1.143).

17
18 10. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the
19 inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently


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1 named inventors is no longer an inventor of at least one claim remaining in the application. Any
2 amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the
3 fee required under 37 CFR 1.17(i).

4
5 11. Any inquiry concerning this communication or earlier communications from the examiner
6 should be directed to Jong-Suk (James) Lee whose telephone number is (703) 308-6777.

7
8 J. Lee /jjl
9 November 30, 2001


10 **Jong-Suk (James) Lee**
11 **Patent Examiner**
12 **Art Unit 3673**